REMARKS

GENERALLY

A current and Non-final Office Action is dated 03/13/2007. In this current Office Action, claims 1-38 were examined, and claims 1-38 were rejected.

With this current Reply, no claims are added, but claims 6, 7, 11, 14, and 27 are canceled. Thus, claims 1-5, 8-10, 12, 13, 15-26, and 28-38 are now presented for examination.

The current Office Action reads (in pertinent parts with highlighting omitted) as follows at the indicated numbered paragraphs:

3.   As to claims 1-11 and 28, the claims are rejected under U.S.C. 101 as they are not limited to tangible embodiments.

4.   As to claims 12-19, they are rejected under U.S.C. 101 as the claimed "device" is software per se, as it is not tangibly embodied, failing to recite any hardware as part of the device.

5.   As to claims 20-27, the claims are rejected under U.S.C. 101 as they are directed to an arrangement, which appear to be software per se, as not being tangibly embodied, failing to recite any hardware as part of the arrangement.

7.   Claims 1-6, 8, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bates et al. (hereafter Bates(I))(US Pat. 6,077,312) in view of Bates et al. (hereafter Bates(II))(US Pat. 6,493,834).

18.   Claims 7, 10, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bates(I) in view of Bates(II) as applied to claim 1 above, and further in view of Angel et al. (hereafter Angel)(US Pat. 6,314,558).

23.   Claims 12-27, 29-31, 33, 34, and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bates(II) in view of Angel.

51.   Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bates(I) in view of Bates(II) and further in view of Inamdar (US Pub. 2003/0149960).

56.   Claims 32 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bates(II) in view of Angel and further in view of Inamdar.

RESPONSE TO REJECTIONS UNDER 35 U.S.C. § 101

The current Office Action rejected claims 1-28 under 35 U.S.C. §101. The propriety and legitimacy of the 35 U.S.C. §101 rejection is hereby respectfully traversed. Nevertheless, to facilitate prosecution of the instant Patent Application and to expedite its ultimate allowance as a U.S. Patent, claims 1-11 and 20-28 have been amended in manners believed to overcome the instituted 35 U.S.C. §101 rejections.

For claims 1-11 and 28, the claims now recite **one or more processor-accessible storage media.**

For claims 12-19, it is respectfully submitted that it is clear from the Specification of the instant Patent Application that the term **device** includes a hardware component.

For claims 20-27, independent claim 20 now recites **the arrangement including one or more processor-accessible storage media.**

Accordingly, withdrawal of the 35 U.S.C. §101 rejections is hereby respectfully requested.

ARGUMENT(S) AGAINST THE 35 U.S.C. § 103(a) REJECTIONS

Several claims as previously examined recited **instruction type indicator, indication of an instruction type**, or similar. Examples include claims 7, 14, 22, 28 (which is independent), and 31.

The current Office Action appears to reject this element with reference to Column 9, Lines 28-32 of Angel et al. For instance, the following paragraphs 19 and 22 are from pages 6 and 7/8 of the current Office Action:

> 19. As to claim 7, Bates(I) and Bates(II) do not disclose injecting an instruction type indicator that indicates an instruction type for the instruction of the line of common intermediate language code.
>
> However, Angel discloses injecting an instruction type indicator that indicates an instruction type for the instruction of the line of common intermediate language code (column 9, lines 28-32).

> 22. As to claim 28, Bates(I) and Bates(II) disclose one-or more processor-accessible media comprising an instrumentation tool that is capable of determining whether respective instructions from common intermediate language code meet at least one predetermined criterion ...
> [...]
> ... and Angel discloses each injected respective decision point including an indication of an instruction type of the respective associated instruction (column 9, lines 28-32).

Angel et al. (U.S. Patent No. 6,314,558) reads as follows at Column 9, Lines 26-35 (with Lines 28-32 highlighted in *italics*):

> The data that is read from the IR data element 64 and processed by the tree construction software 62 could be *stored in a computer file. In other embodiments, data may be stored in computer memory or stored using any one of a variety of means sufficient for providing the IR data element 64. Each node may be represented by a variable length record having conventional type and size indicators. In the* embodiment illustrated herein, it is assumed that the data

is stored in a conventional computer file with the operands corresponding to a node being at an earlier point in the file than the node itself. For example, if a particular node representing the addition operation has two children representing the first and second operands that are being added, then the three nodes (parent and two children) may be stored in the file with the first and second operands being located sequentially prior to the node indicating the addition operation. Accordingly, for any tree or subtree, the root node may be located in the file following all of the children nodes. In a preferred embodiment, the data from the IR data element 64 is first read into a flat list (such as a linked list or an array). Then the flat list is processed to provide the tree 80. The nodes that are part of the flat list may be the same nodes stored in the tree 80 (i.e., the same data), with the tree 80 being constructed by simply adding links to the nodes in the flat list to form the tree 80. Alternatively, the flat list may be part of the IR data element 64.

A review of this paragraph and the remainder of Angel et al. reveals that the referenced type refers to a node type (see, e.g., Angel et al., Column 8, Lines 14-38). It is respectfully submitted that node type does not correspond to instruction type. Moreover, it is respectfully submitted that there is neither teaching nor motivation to inject a node type indication into a code as part of a breakpoint or for any other purpose.

For at least these two reasons, it is respectfully submitted that no art of record, either alone or in any combination, teaches or otherwise renders obvious **instruction type indicator, indication of an instruction type,** or similar.

Hence, no art of record, either alone or in any combination, anticipates or renders obvious at least the following element(s) in conjunction with the other elements of their respective claims:

Claim 1: the bookmark entry including an **instruction type indicator** that indicates an instruction type for the instruction of the line of common intermediate language code.

Claim 12: wherein the bookmark entry comprises an **indication of an instruction type** of the associated instruction and an identifier of the decision point.

Claim 20: means for injecting a respective bookmark entry that **indicates an instruction type** of the respective individual instruction associated with the respective decision point.

Claim 28: each injected respective decision point including an **indication of an instruction type** of the respective associated instruction.

Claim 29: wherein the injecting a decision point comprises injecting an **indicator of an instruction type** of the instruction.

For the reasons provided above, it is respectfully submitted that independent claims 1, 12, 20, 28, and 29 are allowable. Moreover, although each of the pending dependent claims also includes additional element(s) militating toward allowability, they are allowable at least for the reasons given above in connection with their respective independent claims.

Accordingly, withdrawal of the 35 U.S.C. §103(a) rejections is hereby respectfully requested.

CONCLUSION

It is respectfully submitted that all of pending claims 1-5, 8-10, 12, 13, 15-26, and 28-38 are allowable. Consequently, allowance of claims 1-5, 8-10, 12, 13, 15-26, and 28-38 is hereby respectfully requested.

Respectfully Submitted,

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